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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,057	03/12/2004	Cindy A. Sprecher	93-14D5	9117

7590

10/02/2006

Brian J. Walsh  
Patent Department  
ZymoGenetics, Inc.  
1201 Eastlake Avenue East  
Seattle, WA 98102

EXAMINER

CARLSON, KAREN C

ART UNIT PAPER NUMBER

1653

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/800,057

Applicant(s)

SPRECHER ET AL.

Examiner

Karen Cochrane Carlson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10,12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, 12, and 14-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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This Office Action is in response to the paper filed on August 11, 2006.

Claims 2, 11, and 13 have been canceled. Claims 1, 3-10, 12, and 14-22 are currently pending and are under examination.

Priority is set to November 5, 1993.

**Withdrawal of Rejections:**

The rejection of Claims 5-11 and 16-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,455,338, is withdrawn in view of the terminal disclaimer filed August 11, 2006.

The rejection of Claims 1-4 and 12-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,914,315, is withdrawn in view of the terminal disclaimer filed August 11, 2006.

The provisional rejection of Claims 1-4 and 12-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/680,684 (US 2004/0253686), is withdrawn in view of the terminal disclaimer filed August 11, 2006.

The rejection of Claims 2, 11, and 13 under 35 U.S.C. 112, first paragraph, is withdrawn in view of the cancellation of these claims.

**Maintenance of Rejections:**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 3-10, 12, and 14-22 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 10, 12, and 21 refer to "highly stringent hybridization conditions". These conditions are not set forth in the specification - see Detailed Description of the Invention, at paragraph 12, stringency is discussed but not conditions are set forth. Therefore, one skilled in the art cannot know what is intended by this limitation.

Claim 5 refers to the DNA of Claim 1. Claim 1 is drawn to a protein, not to a nucleic acid. See also Claim 16. Claim 16 refers to the DNA of Claim 12, but Claim 12 is drawn to a protein and not to a nucleic acid.

This rejection is being maintained regarding hybridization conditions because the new amendments to the claims to set forth the conditions is new matter. Thus, this rejection stands because if the new matter is taken out and not replaced with conditions set forth in the specification, for example, then this rejection would be re-instated. Thus, as a matter of "book keeping", this rejection has been reiterated with regard to the hybridization conditions.

Applicants have inserted hybridization conditions taken from Sambrook, a well-known molecular biology methods book. Applicants urge that at page 8 this teaching from Sambrook is incorporated by reference. At page 8, the use of Sambrook to identify regulatory regions within 5' and 3' UTRs is what is incorporated by reference. Indeed, the hybridization conditions amended into the claims do not correspond to the conditions that Applicants themselves used in Example 1. Placing the hybridization conditions from Example 1 into the claims would overcome this rejection.

Applicants did not address the Examiner's comments regarding Claims 5 and 16 by amendment or by argument.

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**New Rejection:**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-10, 12, and 14-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is a new matter rejection. Applicants have inserted hybridization conditions taken from Sambrook, a well-known molecular biology methods book. Applicants urge that at page 8 this teaching from Sambrook is incorporated by reference. At page 8, the use of Sambrook to identify regulatory regions within 5' and 3' UTRs is what is incorporated by reference. Indeed, the hybridization conditions amended into the claims do not correspond to the conditions that Applicants themselves used in Example 1. Placing the hybridization conditions from Example 1 into the claims would overcome this rejection.

No Claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

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mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**KAREN COCHRANE CARLSON, PH.D**  
**PRIMARY EXAMINER**